

## REMARKS

Claims 12, 15, 26-37, 47, 50, 57-63 and 76-79 are canceled in this paper. Claims 1-2, 16, 18, 38 and 51 are amended in this paper. No claims are added in this paper. Therefore, claims 1-11, 13-14, 16-25, 38-46, 48-49 and 51-56 are pending and are under active consideration.

In the outstanding Office Action, the Patent Office states that the “[f]irst paragraph of the application should include a cross-reference to related application. In particular, it is noted that this application is a 371 of PCT/US00/17703, which claims benefit of 60/142,728.”

In response to the foregoing, Applicants have herein amended the present specification to make note of the fact that the present application is a 371 of PCT/US00/17703. Applicants note that, in the Preliminary Amendment filed with the present application on January 7, 2002, the specification was amended to include a cross-reference to USSN 60/142,728. Therefore, in view of the above, the specification now includes the cross-reference requested by the Patent Office.

Claims 1-14 and 38-49 stand rejected under 35 U.S.C. 112, first paragraph, “because the specification, while being enabling for a release coating of crosslinked acid functionalised  $\alpha$ -olefin containing copolymer, does not reasonably provide enablement for a release coating having a total surface energy of about 25 to 35 mN/m, of which about 0.1 to 4 mN/m is polar surface energy. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.” More specifically, the Patent Office states the following:

More particularly, it is noted that the independent claims 1 and 38 recite “a release coating having a total surface energy of about 25 to 35 mN/m, of which about 0.1 to 4 mN/m is polar surface energy” (as a genus having certain properties), whereas the Specification only discloses a release coating of crosslinked acid

functionalised  $\alpha$ -olefin containing copolymer (Specification, page 17, first paragraph), the disclosure is considered insufficient to represent “a release coating having a total surface energy of about 25 to 35 mN/m, of which about 0.1 to 4 mN/m is polar surface energy” as a genus per se. As such, the absence of the critical elements of suitable polymer compositions in claims 1 and 38 renders the instantly claimed invention unduly broad and in excess of its provided disclosure. It should be noted that the written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice...by functional characteristics coupled with a known or disclosed correlation between function and structure...sufficient to show the applicant was in possession of the claimed genus. If a representative number of adequately described species are not disclosed for a genus, the claim to that genus must be rejected as lacking adequate written description under 35 U.S.C. 112, first paragraph. See MPEP § 2163.IIA3(a)ii.

Finally, the preamble “A transfer label” of claims 38-49 also appears unduly broad and in excess provided enablement of the Specification, because clearly only a label suitable for transferring under a heated process (Examples 1-5) has been disclosed. Cancellation is suggested.

Applicants respectfully traverse the foregoing rejection. As best understood by Applicants, the Patent Office is apparently contending that independent claims 1 and 38 lack enablement because, whereas the claims recite a release coating having a total surface energy of about 25 to 35 mN/m, of which about 0.1 to 4 mN/m is polar surface, the specification is allegedly enabling only for a release coating of crosslinked acid functionalised  $\alpha$ -olefin containing copolymer. Although disagreeing with the merits of the Patent Office’s contention, Applicants, in an effort to place the present application in condition for allowance, have amended claims 1 and 38 so that they now recite the limitations of claim 15, namely, that the carrier is made of a polymer selected from the group consisting of polyesters, polyolefins and polyamides and that the release coating is made by (A) applying to the carrier in its amorphous or semi-oriented state a composition comprising (1) a

functionalized  $\alpha$ -olefin containing copolymer and (2) a crosslinking agent; and (B) reacting said composition with the carrier during uniaxial or biaxial stretching and heat setting.

In view of the above, the foregoing contention of the Patent Office has been overcome.

With respect to claims 38-49, the Patent Office is apparently also contending that the preamble lacks enablement for the alleged reason that the specification only discloses a label suitable for transferring under a heated process. Applicants respectfully disagree with the foregoing contention. The specification is not limited to heat-transfer labels. To the contrary, the specification specifically mentions, at page 12, lines 19-21, at page 20, lines 24-25, and in originally filed claims 38-49, that a pressure-sensitive adhesive may be used in place of a heat-activatable adhesive. To the extent that the Patent Office is apparently requiring the inclusion of actual working examples to satisfy the Enablement Requirement, Applicants respectfully submit that the Patent Office is in error. (See MPEP 2164.02 which provides that “[c]ompliance with the enablement requirement of 35 U.S.C. 112, first paragraph, does not turn on whether an example is disclosed.”) The Patent Office has provided no reason as to why a person of ordinary skill in the art would be unable to practice the invention of claim 38 without requiring undue experimentation. In the absence of such a reason, the Patent Office must accept the specification as enabling.

Accordingly, for at least the above reasons, the foregoing rejection should be withdrawn.

Claims 1-25 and 38-56 stand rejected under 35 U.S.C. 112, second paragraph, “as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” In support of the rejection, the Patent Office states the following:

In independent claims 1 and 38, the structural relations of the layers, are vague and indefinite. The examiner would like to suggest

combining the structural limitations of claims 3 and 4 into claim 1, and claims 40 and 41 into claim 38, respectively.

In claims 15 and 50, line 3 of each claim, the term (B) appears to be a typo. For the purpose of this Office action, it is presumed to be (b).

Additionally, for claims 1 and 38, the recitation “a release coating having a total surface energy of about 25 to 35 mN/m, of which about 0.1 to 4 mN/m is polar surface energy” is vague and indefinite, because it gives no notice as to what constitutes infringement upon the instantly claimed invention. It should be noted that claims merely setting forth physical characteristics desired in article, and not setting forth specific structure and/or compositions which would meet such characteristics, either in the claim or Specification, are invalid as vague, indefinite, and functional, since it recites compounds by what it is desired that they do rather than what they are. As such, it is unclear as to what is the scope of the invention of which Applicant intends to claim. Ex parte Slob (PO BdApp) 157 USPQ 172. (Emphasis in original.)

Applicants respectfully traverse the foregoing rejection. With respect to the first ground relied upon by the Patent Office, namely, that the structural relations of the layers are allegedly vague and indefinite, Applicants, although disagreeing with the merits of the contention, have amended claims 1 and 38 so that it is clear that the first release coating is positioned over the carrier, the ink design layer is positioned over the first release coating and the adhesive layer is positioned over the ink design layer.

With respect to the second ground relied upon by the Patent Office, namely, the occurrence of “(B)” in claims 15 and 50, the ground is moot in view of Applicants’ cancellation herein of claims 15 and 50.

With respect to the third ground relied upon by the Patent Office, namely, that the language “a release coating having a total surface energy of about 25 to 35 mN/m, of which 0.1 to 4 mN/m

is polar surface energy" is vague and indefinite for allegedly failing to give notice of what constitutes infringement of the claims, Applicants respectfully disagree. As noted in connection with the previous rejection, claims 1 and 38 have been amended herein to recite chemically the type of composition used to form the release coating. Therefore, to the extent that the Patent Office is contending that the claims merely set forth physical characteristics without setting forth structure and/or compositions that would meet such characteristics, the basis for the rejection has been overcome. In any event, however, Applicants respectfully disagree with the Patent Office's assertion that the language in question fails to give one notice as to what constitutes infringement of the claims. The mere fact that the limitation in question recites a physical property, as opposed to a structural property or a chemical formula, does not prevent the limitation from defining the scope of the invention. The characteristic in question can be measured in an allegedly infringing label and determined either to meet the claim language or not. Consequently, the language in question is definite.

Accordingly, for at least the above reasons, the foregoing rejection should be withdrawn.

Applicants note that the present invention has not been rejected on the basis of any prior art. Therefore, in view of the fact that all non-art related rejections should be withdrawn for the reasons above, it is respectfully submitted that the present application is now in condition for allowance. Prompt and favorable action is earnestly solicited.

If there are any fees due in connection with the filing of this paper that are not accounted for, the Examiner is authorized to charge the fees to our Deposit Account No. 11-1755. If a fee is

required for an extension of time under 37 C.F.R. 1.136 that is not accounted for already, such an extension of time is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 30, 2004.

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